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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/912,723	07/23/2001	Mark A. Lauer	LAUM-004	5523

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EXAMINER

KLIMOWICZ, WILLIAM JOSEPH

ART UNIT PAPER NUMBER

2652

DATE MAILED: 01/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.



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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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EXAMINER

ART UNIT	PAPER
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01182006

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner for Patents

See enclosed attachment.

William J. Kimowicz
Primary Examiner
Art Unit: 2652

BM

Office Communication

Claim Status

Claims 1-4, 6-14 and 17-29 are currently pending.

Claims 5, 15 and 16 have been voluntarily cancelled by the Applicant.

Discussion of Drawing Objections

In the Office action made FINAL mailed July 6, 2005, the Examiner objected to the drawings under 37 CFR 1.83(a). More specifically, claims 23, 26 and 29 were added after the filing of the original disclosure. The claims 23, 26 and 29 set forth the limitation “wherein no part of said substrate is disposed further than said transducer from said actuator.”

Having found no facts or evidence to support such a limitation in the drawings, whatsoever, the Examiner in the Office action made FINAL, mailed July 6, 2005, objected to the drawings under 37 CFR 1.83(a). The Examiner clearly stated:

The drawings must show every feature of the invention specified in the claims. Therefore, the “wherein no part of said substrate is disposed further than said transducer from said actuator” must be shown or the feature(s) canceled from the claim(s).

Moreover, as set forth in the Office action made FINAL, mailed July 6, 2005, the Examiner expressly stated that “Applicant should very carefully review the specification and drawings and ensure that no new matter is presented that would conflict with the original drawings and disclosure.” The Examiner further stated:

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are

required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). ***If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.***

Emphasis in bold italics is being currently added.

Moreover, the Examiner maintains that the facts preclude the Applicant from modifying the drawings to meet the limitations found in newly presented claims 23, 26 and 29.

The evidence includes, by example only, the Applicant's own description of the gimbal and flexure, which comprise "a plurality of conductive leads 52, 53, 54 and 55 [are] disposed in the flexures 38, connected with transducer leads 56, 57, 58 and 59 disposed in gimbal elements 35." Emphasis added. See paragraph [0044] of Applicant's original specification. Moreover still, as described by the Applicant's original specification, the conductors 56 and 58 can be used in the etching process during formation of the flexure and gimbal, as an "etch-stop signal." As concretely and unambiguously stated by the Applicant, "[e]xact control of the depth of etching in the Z-direction [for the etch formation of the gimbal and flexure which are formed/shaped from the substrate] may be accomplished by timing or by monitoring the etching process for evidence of conductors 56 and 58, which have been formed to a distance predetermined to serve as an etch-stop signal." See paragraph [0050] of Applicant's original specification. Thus not only do

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each and every pertinent drawing in the Applicant's originally filed application depict that the transducers and conductors are formed on a major, and apparently recessed, surface of the substrate, the Applicant's original specification seemingly mandates it. Clearly as paragraph [0050] of the Applicants' original specification states, the substrate is then etched preferably via an anisotropic etch, and once the recessed conductors have been reached at the predetermined distance ("which have been formed to a distance predetermined to serve as an etch-stop signal)," the etching stops, and the flexure (or gimbal) substrate thickness, is determined.

The Applicant, in an after-final amendment filed on October 3, 2005, attempted to file a drawing modification in conjunction with a revision to paragraph [0067] of the original specification.

In a subsequent Advisory action, Paper No. 11012005, mailed **November 2, 2005**, the Examiner noted that such a change to the drawing and specification constituted new matter. As noted by the Examiner in the Advisory action:

The proposed amendment to the drawings, particularly Figure 20, and the modification of at least paragraph [0067] in conjunction therewith, would be objected to under 35 U.S.C. 132(a), if entered, because it introduces new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

The arbitrary addition of a major surface 401, as attempted to be introduced into FIG. 20, is shown to be completely planar and extending across the entirety of the wafer width, yet portions of the slider wafer must clearly extend beyond such a plane. That is, e.g., FIGS. 1 and 20 of Applicant's specification clearly show wherein the head (33) and substrate layer and the rear portion of pad (50) itself, extend beyond the transducer layers (40) and (44). That is, the transducer layers appear to be formed on and within the substrate, on a major surface of the slider wafer, which is recessed into a portion of the slider. In fact, it cannot be ascertained as to how no part of the substrate is disposed further that the transducer (40, 44) from the actuator, as seen in FIGS. 1 and 20. Clearly, the very end of the slider wafer substrate adjacent designator (33) in FIG. 20 extends above the planar arbitrary surface (401). Is the distal end portion of the slider farthest from the actuator (410) in FIG. 20, and the gimbal itself -- a major portion

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of which clearly extends father [sic; farther] from the actuator than the transducer (40, 44) as depicted in the Applicant's originally filed disclosure -- somehow not part of the wafer substrate; and if not, then what is it made of? Does the "major surface" as set forth originally in the Applicant's disclosure, required now to be a planar surface extending across the entire width of the of a [sic; of a] portion of the slider distal surface, with no deviations from planarity? As set forth previously by the Examiner, if there is no new matter, the Applicant must present all such FIGS. Analogous to FIG. 1 and FIG. 20 clearly and unambiguously disclosing that the substrate can have no portion beyond the layer (44) (e.g., showing layers (44 and (44) [sic; (40) and (44)] formed on a dotted line, wherein the dotted line indicates the end of the substrate with the transducer layers formed with a protection layer.

How this affects the lead layers (56-59) is, however, unclear. Are these layers (56-59) to be also within a protective layer formed on the substrate? This would seem inconsistent with the Applicant's own disclosure in paragraph [0044], wherein it is specifically stated "leads 56, 57, 58 and 59 [are] disposed in gimbal elements 35." Applicant should very carefully review the specification and drawings and ensure that no new matter is presented that would conflict with the original drawings and disclosure.

Since the proposed amendments to the drawings introduce new matter not supported by the disclosure as originally filed, the proposed After-Final amendment filed on October 3, 2005 will not be entered.

Instead of correcting the objected to drawings, filing a Petition under 37 CFR 1.181, or canceling claims 23, 26 and 29, (note that objections are *petitionable*, not appealable), the Applicant then filed an Appeal Brief on December 12, 2005, arguing, *inter alia*, that the rejections of claims 23, 26 and 29, as it pertains to under 35 USC 112 first and second paragraphs, should not stand.

As previously noted by the Examiner, "[i]f the [drawing] changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. ***The objection to the drawings will not be held in abeyance.***"

That is, the drawings are now **required** to show explicitly the limitations found in claims 23, 26 and 29, *without introducing new matter* into the drawings. The drawings are still

objected to until a time such that a drawing modification can be made to include the limitations of claims 23, 26 and 29 into the drawings, *without new matter*, otherwise claims 23, 26 and 29 must be cancelled. The Applicant had the opportunity to petition the Examiner's holding of new matter in the amended drawings filed on October 3, 2005, thus preserving the right to enter such material into the disclosure, (and thus, by possible extension, the merits of claims 23, 26 and 29), but the two month non-extendible time period for filing such a petition has passed.

As set forth in MPEP 608.02:

If the examiner discovers new matter in a substitute or additional drawing, the drawing should not be entered. The drawing should be objected to as containing new matter. A new drawing without such new matter may be required if the examiner determines that a drawing is needed under 37 CFR 1.81 or 37 CFR 1.83. The examiner's decision would be reviewable by filing a petition under 37 CFR 1.181. The Technology Center (TC) Director would decide such a petition.

It is noted that the Applicant has failed to timely file a Petition pertaining to the objected to drawings, based on claims 23, 26 and 29. Note that 37 CFR 1.181(f) states:

The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

Thus, in accordance with U.S. Patent rules and regulations regarding such objectionable matters, the Applicant is required to correct the drawings in the manner described by their original specification or cancel claims 23, 26 or 29. How the Applicant would modify the drawings to be in accordance with the limitations set forth in claims 23, 26 or 29 is not

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known. The Applicant's time period for filing a Petition regarding the new matter situation raised by the Examiner has now passed.

If Applicant chooses to cancel claims 23, 26 and 29, a Supplemental Appeal Brief may be required.

Conclusion

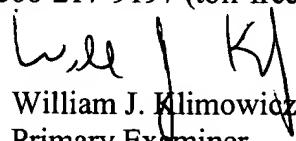
See 37 CFR 1.111 and 37 CFR 1.121. Since the above-mentioned reply appears to be *bona fide*, applicant is given **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission, correction or petition in order to avoid abandonment. **EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William J. Klimowicz whose telephone number is (571) 272-7577. The examiner can normally be reached on Monday-Thursday (6:30AM-5:00PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, A. L. Wellington can be reached on (571) 272-4483. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


William J. Klimowicz
Primary Examiner
Art Unit 2652

WJK